# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/749,595 | 12/28/2000 | Ravi Ganesan | 3350-67 | 4823 |

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| EXAMINER |
|---|
| SNAPP, SANDRA S |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3624 | |

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

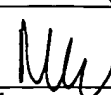| | | Application No. | Applicant(s) |
|---|---|---|---|
| **Office Action Summary** | | 09/749,595 | GANESAN ET AL. |
| | | Examiner | Art Unit |
| | | Sandra Snapp | 3624 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>01-07-04</u>.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-40</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-40</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 December 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date <u>01-07-04</u>.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

# DETAILED ACTION

## *Information Disclosure Statement*

The information disclosure statement (IDS) submitted on 01-07-04 was filed in

compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure

statement has been considered by the examiner.

## *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by the Randle et al.

patent (US 6,594,647 B1).

The Randle reference discloses a method and associated system for ameliorating financial

risk in providing electronic payment services, comprising:

Receiving, via a network, a request to execute a payment on behalf of a network user

associated with two or more user identifiers, the request including a first user identifier (col. 7,

lines 15-65),

Processing previous requests executed on behalf of the network user, each previous

request including one of the two or more user identifiers, to determine if the request will be

accepted for execution (col. 7, lines 32-65), and

If the determination is to accept the request for execution, directing a debit from an

account associated with the network user (col. 7, lines 62-65) (Claims 1 and 40);

Receiving, via a network, a request to execute a payment on behalf of a network user, the

request including a user identifier associated with the network user (col. 7, lines 32-65),

Identifying all user identifiers associated with the network user (col. 7, lines 15-26),

Processing previously executed payments associated with each identified user identifier

to determine if the request will be accepted for execution (col. 7, line 67 through col. 8, line 20),

Transmitting, via the network, the determination (col. 7, lines 55-65),

A communications port (col. 5, lines 9-20),

A memory (col. 4, lines 49-56), and

A processor (col. 3, lines 30-47) (Claims 2 and 21);

The determination is transmitted to the network user (col. 7, lines 55-65), and

The transmission is a real-time transmission (col. 3, lines 53-61) (Claims 3 and 22);

Determining a total monetary value of previously executed payments executed in one or more time periods (col. 8, lines 21-51),

Determining if the total monetary value of previously executed payments executed in the one or more time periods exceeds one or more threshold values (col. 8, lines 21-51), and

If the determination is the total monetary value of previously executed payments executed in the one or more time periods does exceed one or more threshold values, not accepting the request for execution (col. 7, lines 55-65 and col. 8, lines 21-51) (Claims 4 and 23);

The user identifier included with the request is also associated with a sponsor (col. 8, lines 21-40), and

At least one of the one or more threshold values and the one or more time periods is based upon the identity of the sponsor (col. 8, lines 21-40) (Claims 5 and 24);

Determining if the total monetary value of previously executed payments in the one or more time periods in combination with an amount of the payment exceeds one or more threshold values (col. 8, lines 21-40), and

If so determined, not accepting the request for execution (col. 7, lines 55-65 and col. 8, lines 21-40) (Claims 6 and 25);

Determining a total number of previously executed payments executed in one or more time periods (col. 8, lines 21-51),

Determining if the total number of previously executed payments executed in the one or more time periods exceeds one or more values (col. 8, lines 21-51), and

If the determination is the total number of previously executed payments executed in the one or more time periods does exceed one or more values, not accepting the request for execution (col. 7, lines 55-65 and col. 8, lines 21-40) (Claims 7 and 26);

The user identifier included with the request is also associated with a sponsor (col. 8, lines 21-40), and

At least one of the one or more values and the one or more time periods is based upon the identity of the sponsor (col. 8, lines 21-40) (Claims 8 and 27);

The payment is one of (1) a payment of a bill, (2) a gift, (3) a payment for the purchase of goods or services made via the network, and (4) a payment for goods or services purchased from an Internet auction (col. 7, lines 15-26) (Claims 9 and 28);

If the determination is to accept the request for execution, further comprising:

Directing a debit from an account associated with the network user at a first time (col. 3, line 66 through col. 4, line 3), and

Directing a credit to a payee at a second time (col. 3, line 66 through col. 4, line 3),

Wherein the second time is subsequent to the first time, and wherein a time period between the first time and the second time is a determined time period (col. 3, line 66 through col. 4, line 3) (Claims 10 and 29);

Processing previously executed payments associated with each identified user identifier to determine the time period (col. 8, lines 21-40) (Claims 11 and 30); and

Determining the time period based upon at least one of (1) an amount of the payment, (2)

the identity of the network user, (3) an association maintained by the network user, and (4)

payments previously executed on behalf of the network user (col. 8, lines 21-40) (Claims 12 and

31).


The Randle reference discloses a method and associated system for processing a payment

request, comprising:

Receiving a request via a network to execute a payment to a payee on behalf of a network

user (col. 7, lines 15-65),

Determining a time period for crediting the payee subsequent to debiting an account

associated with the network user (col. 8, lines 21-40 and col. 3, line 66 through col. 4, line 3),

Directing a debit from the network user account at a first time, the first time beginning

the determined time period (col. 3, line 66 through col. 4, line 3),

Directing a credit to the payee at a second time, the second time at the end of the

determined time period (col. 3, line 66 through col. 4, line 3),

A communications port (col. 5, lines 9-20),

A memory (col. 4, lines 49-56), and

A processor (col. 3, lines 30-47) (Claims 13 and 32);

The payee is also a network user (col. 3, line 66 through col. 4, line 3) (Claim 33);

The determined time period is determined based upon at least one of (1) the identity of

the network user, (2) an amount of the payment, (3) an association maintained by the network

user, and (4) payments previously executed on behalf of the network user (col. 8, lines 21-40) (Claims 14 and 34);

The request includes a user identifier associated with the network user, further comprising:

Identifying all user identifiers associated with the network user (col. 7, lines 15-65),

Processing previously executed payments associated with each identified user identifier to determine the period (col. 8, lines 21-40) (Claims 15 and 35);

Determining a total monetary value of previously executed payments executed in one or more time periods (col. 8, lines 21-51), and

Determining if the total monetary value of previously executed payments executed in the one or more time periods exceeds one or more threshold values to determine the period (col. 8, lines 21-51) (Claims 16 and 36);

The user identifier included with the request is also associated with a sponsor (col. 8, lines 21-40), and

At least one of the one or more threshold values and the one or more time periods is based upon the identity of the sponsor (col. 8, lines 21-40) (Claims 17 and 37);

Determining if the total monetary value of previously executed payments in the one or more time periods in combination with an amount of the payment exceeds one or more thrashold values to determine the period (col. 8, lines 21-40) (Claim 18);

Determining a total number of previously executed payments executed in one or more time periods (col. 8, lines 21-51), and

Determining if the total number of previously executed payments executed in the one or

more time periods exceeds one or more values to determine the period (col. 8, lines 21-51)

(Claims 19 and 38); and

The user identifier included with the request is also associated with a sponsor (col. 8,

lines 21-40), and

At least one of the one or more values and the one or more time periods is based upon the

identity of the sponsor (col. 8, lines 21-40) (Claims 20 and 39).

## *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. The Pieterse, Pollin, Ishikawa, O'Leary, Gross, Bissonette, McKeen, Johnson,

Cotton, Polk and Landry references are all directed to various types of electronic payment

systems.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The

examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system.  Status information for published applications

may be obtained from either Private PAIR or Public PAIR.  Status information for unpublished

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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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